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Date: October 16, 2009 Signature: _____
Sanro Zlotnec, Reg. No. 52,535

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: U.S. Patent Application of Dominique GAUTHIER *et al.*

App. No.: 10/644,932 Group Art Unit: 2462

Filed: August 21, 2003 Examiner: Wanda Z. RUSSELL

For: METHOD AND SYSTEM OF HANDOFF

ARGUMENTS TO ACCOMPANY
PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

The present Arguments accompany a Pre-Appeal Brief Request For Review. The Office is respectfully requested to consider the remarks presented herein below.

As detailed herein below, Applicant believes that the Examiner's position regarding the teachings of Han et al. is incorrect, and moreover is contrary to the position adopted by the Examiner earlier during prosecution. This has inevitably led to an incorrect conclusion regarding anticipation of claims 1-24, 27, 30-32 and 34-40 by Han et al.

To begin, Applicant refers to Page 3 of the (previous) Office Action dated February 12, 2009, where the Examiner stated that Han et al. discloses:

> "[...] a converter (see 100 & 500 in Fig. 2) coupled to said input device and aid output device (see Fig. 2 100 is between 200 and 530) for translating the handoff from the first mode into the second mode (the IF amplifier/divider 100 coupled to the digital MODEM 200 (FIG. 2) transmits a first potion of the divided IF signal through the service RF path unit 500 for generating a frequency #1 (which is utilized for actual communication), and a second portion of the divided IF signal through the RF path unit 530 for producing frequency #3 (which is utilized for generating a pilot signal), refer to col. 5, lines 9-13; and A second digital MODEM 210, which is coupled to a service RF path unit 410, produces an intermediate frequency which results in a frequency #2 ... It is to be understood that the term "service RF path unit" used herein will refer to an RF path unit that is used solely for actual communication, whereas the term "RF path unit" will refer to an RF path unit that is used solely for transmission of a pilot signal, see col. 4, lines 61-64 & 65-67); the second mode handoff signal [...]"

Applicant duly considered the Examiner's point of view and, in a response filed on May 7, 2009, clearly demonstrated how, in Applicant's opinion, the claims in their current form distinguish over Han et al.

Subsequently, in the Final Action dated July 24, 2009, the Examiner provided a new interpretation of Han et al. and re-applied the reference against the claims. It is Applicant's respectful view that the Examiner's new interpretation of Han et al. is erroneous.

In particular, and although the Examiner indicated that "[t]he examiner added more details to clarify the rejection", the paragraph containing the above-cited passage from the Office Action dated February 12, 2009 was replaced with a *less* detailed paragraph in the Final Action dated July 24, 2007, namely one which reads as follows (in relevant part):

> "[...] a converter (see 100 working with 500 in Fig. 2) coupled to said input device and said output device (see Fig. 2 100 is coupled to 200 and 500) for translating the handoff signal from the first mode into the second mode (from FA#1 into FA#2 in Fig. 2); the second mode handoff signal [...]"

It will be observed that (i) not only did the Examiner not provide more details regarding the contentious issue of the claimed "converter", but also (ii) the Examiner altered his interpretation of Han et al. between the previous Office Action and the Final Action. In fact, it will be noted that the Examiner's interpretation of Han et al. has changed to the point where it has become inconsistent with the teachings of Han et al. itself.

A side-by-side comparison of the above-cited passages containing the two contrasting positions adopted by the Examiner may be informative:

Office Action dated February 12, 2009	Final Action dated July 24, 2009	Comments
a converter (see 100 & 500 in Fig. 2)	a converter (see 100 working with 500 in Fig. 2)	Wording is almost identical – no further comment
coupled to said input device and aid output device (see Fig. 2 100 is between 200 and 530)	coupled to said input device and said output device (see Fig. 2 100 is coupled to 200 and 500)	Note that the reference to 530 has been dropped in favor of 500, thereby ignoring the fact that conversion occurs from FA#1 to FA#3
for translating the handoff from the first mode into the second mode	for translating the handoff signal from the first mode into the second mode	Wording is identical – no further comment
(the IF amplifier/divider 100 coupled to the digital MODEM 200 (FIG. 2) transmits a forst potion of the divided IF signal through the service RF path unit 500 for generating a frequency #1 (which is utilized for actual communication), and a second portion of the divided IF signal through the RF path unit 530 for producing frequency #3 (which is utilized for generating a pilot signal), refer to col. 5, lines 9-13; and A second digital MODEM 210, which is coupled to a service RF path	(from FA#1 into FA#2 in Fig. 2);	It is observed that the Examiner has completely changed his position in the Final Action. Previously, the Examiner had considered it important to emphasize that Han et al.'s IF amplifier/divider 100 converts **from frequency #1 to frequency #3**, whereas in the Final Action the Examiner now alleges that conversion occurs **from FA#1 to FA#2**. This is contrary to what Han et al. teaches, as explained below.

unit 410, produces an intermediate frequency which results in a frequency #2 ... It is to be understood that the term "service RF path unit" used herein will refer to an RF path unit that is used solely for actual communication, whereas the term "RF path unit" will refer to an RF path unit that is used solely for transmission of a pilot signal, see col. 4, lines 61-64 & 65-67);		
the second mode handoff signal	the second mode handoff signal	Wording is identical – no further comment

It can thus be seen that the explanation provided by the Examiner regarding the manner in which Han et al. is perceived to teach certain claimed features is in fact **less detailed** in the Final Action (middle column) than in the earlier Office Action (left-hand column). Even more critical is the fact that the Examiner **incorrectly portrays the teachings of Han et al**. Specifically, contrary to the Examiner's new assertion, the IF Amplifier/Divider 100 of Han et al. does **not** convert from FA#1 to FA#2. Instead, as clearly seen in Fig. 2 of Han et al., the digital modem 210 which produces FA#2 is fed directly to the service RF path unit 510 which produces an output **also at FA#2**. Meanwhile, the digital modem 200 which produces FA#1 is connected to service RF path unit 500 (which produces an output at FA#1) and to RF path unit 530 (which produces an output at FA#3). Thus, any "conversion" performed by the IF Amplifier/Divider 100 is between FA#1 and FA#3, and **not** between FA#1 and FA#2 as the Examiner contends—for the first time—in the Final Action.

The Examiner's position regarding the teachings of Han et al. is thus not only at odds with the one adopted previously but, more crucially, is clearly incorrect. This renders the Examiner's conclusion (i.e., that Han et al. anticipates the claimed invention) unfounded, not to mention erroneous.

The Examiner is therefore respectfully requested to abandon the new (incorrect) interpretation of Han et al., and to reconsider Applicant's arguments presented in the

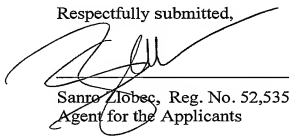
response filed on May 7, 2009 (specifically at pages 11-13), in which it was eloquently shown that **even if** one were to "try to equate frequency #1 with the claimed *first mode* and frequency #3 with the claimed *second mode*", one still has the situation in which Han et al. does not teach or suggest the claimed invention.

Withdrawal of the Examiner's rejection under 35 USC §102 is therefore respectfully requested.

CONCLUSION

In view of the above, it is respectfully submitted that claims 1-24, 27, 30-32 and 34-40 are in condition for allowance, and the Notice of Allowance is earnestly and respectfully solicited.

Respectfully submitted,



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